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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,194	08/31/2004	Irene Lin	5124-00007	5193
26753	7590	06/01/2006		
ANDRUS, SCEALES, STARKE & SAWALL, LLP 100 EAST WISCONSIN AVENUE, SUITE 1100 MILWAUKEE, WI 53202				
			EXAMINER CHANG, VICTOR S	
			ART UNIT 1771	PAPER NUMBER

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/711,194

Applicant(s)

LIN, IRENE

Examiner

Victor S. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 10-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/3/05, 8/31/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of claims 1-6, 8 and 9 in the reply filed on 5/17/2006 is acknowledged. Claims 7 and 10-14 are withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1-6, 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More particularly, claim 1 recites the limitation "said composite layer" in line 3. There is insufficient antecedent basis for this limitation in the claim.

4. Claim 1-6, 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: It is unclear whether the "split upper seam" is formed at the outer surface of the layer of resilient and nontoxic material, or the sealing layer. Clarification is requested.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-6, 8 and 9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/605611. Although the conflicting claims are not identical, they are not patentably distinct from each other because they obviously read on each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1-6, 8 and 9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/645380. Although the conflicting claims are not identical, they are not patentably distinct from each other because they obviously read on each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-4, 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaikema et al. (US 4689936) in view of Challis et al. (US 5672406).

In example 1, Gaikema teaches a packaging product comprising a polypropylene cover having at least one vent hole approximately 0.4 mm in diameter, and the vent hole is closed by a hot melt of ethylene vinyl acetate (sealing layer). Gaikema teaches that, during heat treatment, the hot melt becomes liquid, so that gases can escape through the liquid hot melt (column 4, lines 1-16). The holes may be mechanically cut by a press knife mounted in a punch (column 5, lines 5-6).

For claims 1 and 4, Gaikema lacks an express teaching that the vent hole comprises a split upper seam portion on a top surface and a close lower seam portion. However, it is noted Challis' invention relates to a sheet material having a thermally expandable passage. In Fig. 3, Challis shows in plan view various apertures suitable for forming vent openings, including openings which forms apparent open gaps between edges as well as close gaps having edges in contact (column 3, lines 39-40). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill

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in the art of thermally expandable passages to substitute Gaikema's vent openings with a suitable thermally expandable passages of Challis, including a vent opening having an open gap at one end and a close gap at the other end, because these gaps are functionally equivalent thermally expandable passages. It should be noted that the selection and substitution of a known equivalent material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. Further, it is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. See MPEP § 2144.06. Regarding the term "resilient and nontoxic material", in the absence of evidence to the contrary, since Gaikema teaches the same material (polypropylene) as claimed, as set forth above, it is the Examiner's position that Gaikema's packaging product inherently anticipates material properties as claimed. Additionally, regarding structural features (split gap at one end and close gap at the other end) of the venting holes, since Challis does teach the same composite film materials, and also expressly teach the same hole forming process (by mechanically cutting the composite film with a press knife in a punch), as set forth above, as the instantly claimed "impression process" (see specification, paragraph 0037), in the absence of evidence to the contrary, it is the Examiner's position that the aforementioned structural features are also either anticipated by Challis, or obviously provided by practicing the invention of prior art. It should be noted that where the claimed and prior art products are shown to be identical or substantially identical in structure or composition, or are produced by

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identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. See MPEP § 2112.01.

For claims 2 and 3, Challis clearly shows in Figs. 1-6 the structures of closed and opened passages.

For claim 6, regarding the product-by-process recitation "... performed after said sealing layer is formed on said composite layer ...", the Examiner notes that since the method limitations have not been shown on the record to produce a patentably distinct article, the formed articles are rendered *prima facie* obvious. It should be noted that product-by-process claims are nonetheless product claims, and to be limiting in a product claim, a process limitation must be evidenced as effecting the structure or chemistry of the resultant product over the prior art. Further, the burden of proof for this showing is on Applicant after the Examiner presents an otherwise *prima facie* rejection. See MPEP § 2113.

Finally, for claim 9, Challis teaches that the aperture may be constant or adjustable ranging from one hole to many holes of few microns diameter (column 2, lines 60-64).

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gaikema et al. (US 4689936) in view of Challis et al. (US 5672406) and evidenced by Mueller et al. (US 4404241).

The teachings of Gaikema and Challis are again relied upon as set forth above.

For claim 5, since the thermally reversible functions of Gaikema's hot melt sealing material are exactly the same as the sealing wax of instant invention, it is the Examiner's position that Gaikema's hot melt of ethylene vinyl acetate reads on the

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sealing wax as claimed, as evidenced by the state of the art of Mueller. More particularly, Mueller's invention relates to a microwave package with venting holes which are sealed with an extrudable hot melt material which is adapted to soften and permit venting of vapor generated in the package. Mueller teaches that extrudable hot melts are uniquely suitable for this purpose, including an ethylene-vinyl acetate wax hot melt. As such, in the absence of evidence to the contrary, it would have been obvious to the one skilled in the art of hot melt sealing to select a suitable thermally reversible wax grade ethylene-vinyl acetate for Gaikema's invention.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gaikema et al. (US 4689936) in view of Challis et al. (US 5672406) and Inoue (US 4769175).

The teachings of Gaikema and Challis are again relied upon as set forth above.

For claim 8, Gaikema lacks a teaching of incorporating an oxygen scavenger in the composite film. However, it is noted that Inoue's invention relates to a sheet-like oxygen scavenger for preserving foods (abstract). The oxygen scavenging material may be coated with an additional layer, such as a polyethylene, polypropylene, etc. As such, in the absence of unexpected results, it would have been obvious one of ordinary skill in the art to modify Gaikema's composite by incorporating an oxygen scavenger, as taught by Inoue, motivated by the desire to obtain a food packaging material which improves food preservation.

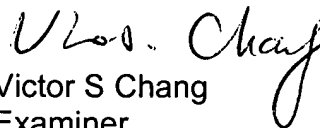
Conclusion

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Victor S Chang
Examiner
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5/26/2006